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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,153	07/14/2003	John DeTreville	MS1-282USC12	6773
22801	7590	08/18/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			DARROW, JUSTIN T	
		ART UNIT		PAPER NUMBER
		2132		

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/619,153	DETREVILLE, JOHN
	Examiner Justin T. Darrow	Art Unit 2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-6 is/are allowed.
- 6) Claim(s) 7-9 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____.

**DETAILED ACTION**

1. Claims 1-9 have been presented for examination.

***Priority***

2. Acknowledgment is made that the instant application is a continuation of Application No. 09/287,699, filed 04/06/1999, now U.S. Patent No. 6,609,199 B1, which is a continuation-in-part of Application No. 09/266,207, filed 03/10/1999, which claims benefit of provisional Application No. 60/105,891, filed 10/26/1998.
3. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/287,699, filed 04/06/1999. The current status of this nonprovisional parent applications referenced must be included by inserting after “Device”, in the specification in page 1, line 4 --now U.S. Patent No. 6,609,199--.

***Information Disclosure Statement***

4. The information disclosure statements (IDSes) submitted on 08/12/2004 and 12/03/2003 were filed before the mailing date of the first Office action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97(b)(3). Accordingly, the information disclosure statements are being considered by the examiner.

***Claim Objections***

5. Claim 9 is objected to because of the following informality: delete “verified” in page 55, line 3 and replace with --verified--. Appropriate correction is required.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 4; 3; and 4, respectively, of U.S. Patent No. 6,609,199 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7 and 8 are one-way obvious over claims 1, and 1 and 3, respectively. See MPEP § 804 II. B. 1(a).

As per claim 7, claim 1 of U.S. Patent No. 6,609,199 B1 recites an apparatus comprising:  
a processor (see column 26, line 25); and  
a nonvolatile memory, coupled to the processor, that stores both data and a program that, when a request to access the data is received, causes the processor to allow access to the data only if the requester can prove that the requester is an application on a list of trusted applications maintained by the apparatus (see column 26, lines 26-31).

As per claim 8, claim 3 of U.S. Patent No. 6,609,199 B1 adds:

wherein the apparatus comprises a smart card (see column 26, lines 42-43).

As per claim 9, claim 4 of U.S. Patent No. 6,609,199 B1 incorporates:

wherein the program further causes the processor to (see column 26, lines 43-44):

send, to the requester, a challenge (see column 26, line 46);

receive a response to the challenge from the requester (see column 26, lines 47);

verify the response (see column 26, lines 48); and

determine whether the requester is an application on the list of trusted applications only after the response is verified (see column 26, lines 48-50).

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkinson et al., U.S. Patent No. 6,308,317 B1.

As per claim 7, Wilkinson et al. discloses an apparatus comprising:

a processor (see column 59-62; figure 12, item 120; loading and execution control providing processing); and

a nonvolatile memory (see column 12, lines 8-9; figure 12, item 124; a card file system stored in EEPROM), coupled to the processor (see column 11, lines 62-66; figure 12, items 120 and 124; the loading and execution control providing necessary system resources to a coupled card file system),

that stores both data and a program that (see column 11, lines 65-66; figure 12, items 124, and 126; a card file system that stores applications; see column 15-18; figure 13, item 16; the Card Java Virtual Machine (Card JVM)); see column 17, lines 17-20; figure 14; item 147; figure 20, item 202; and files stored in the card file system),

when a request to access the data is received (see column 17, lines 56-57; whenever a computational object is accessed by a running application),

causes the processor to allow access to the data (see column 17, lines 56-64; where access to the data object is allowed to proceed)

only if the requester can prove that the requester is an application on a list of trusted applications maintained by the apparatus (see column 17, lines 10-13; figure 20, items 126z and 190c; a specific running application on the integrated circuit card with an authenticated identity; see column 17, lines 36-51; where the authenticated identity is included in an access control list (ACL) to operate on a computational object, such as a data file; see column 17, lines 56-64; where access is allowed to proceed if the identity associated with the running application is matched on the access control list (ACL)).

As per claim 8, Wilkinson et al. further embodies:

that the apparatus is a smart card (see column 7, lines 43-46; figure 1, item 10; where the integrated circuit card is a smart card).

As per claim 9, Wilkinson et al. then suggest:

send, to the requester, a challenge (see column 17, lines 1-9; send the application running on the card plain text, where the encryption of which by the application shows that it possesses the application's identity-defining encryption key);

receive a response to the challenge from the requester (see column 17, lines 1-9; receiving encrypted plain text from the application);

verifying the response (see column 17, lines 1-9; decrypting the encrypted plain text with the application's identity-defining encryption key to show that the application is in possession of the key); and

determine whether the requester is an application on the list of trusted applications (see column 17, lines 10-13; figure 20, items 126z and 190c; a specific running application on the integrated circuit card with an authenticated identity; see column 17, lines 36-51; where the authenticated identity is included in an access control list (ACL) to operate on a computational object, such as a data file; see column 17, lines 56-64; where access is allowed to proceed if the identity associated with the running application is matched on the access control list (ACL)),

only after the response is verified (see column 16, lines 66-67; allowing the card application to run after the showing show that the application is in possession of the key; see column 17, lines 56-64; subsequently access is allowed to proceed if the identity associated with the running application is matched on the access control list (ACL)).

***Allowable Subject Matter***

10. Claims 1-6 are allowed.

11. The following is an examiner's statement of reasons for allowance:

Claims 1-6 are drawn to a system. The closest prior art, Wilkinson et al., U.S. Patent No. 6,308,317 B1, discloses a similar system.

Wilkinson et al. depicts a system comprising:

a portable integrated circuit device (see column 7, lines 43-46; figure 1, item 10; where the integrated circuit card is a smart card) having stored thereon an authentication application (see column 15-19; figure 13, item 16; storing a Card Java Virtual Machine (Card JVM)) providing an authenticated application access) and a definition of a list of trusted applications (see column 17, lines 36-39; and access control list (ACL) stored in the integrated circuit card); and

a computer, coupled to communicate with the portable integrated circuit device (see column 17, lines 65-67; column 18, lines 1-4; figure 13, items 10 and 14; a terminal with a single path between it and the integrated circuit card), to,

form a secure connection between the portable integrated circuit device and an application running on the computer (see column 18, lines 1-6; figure 13, items 209, 10, 14, and 136; a secure channel provided by encryption with a one-time session key between the card application and the terminal application).

However, Wilkinson et al. neither shows nor suggests that the computer receives the list of trusted applications from the portable integrated circuit device, nor identifies to the portable

integrated circuit device that the application is one of the applications in the list of trusted applications. This combination of features explicitly recited in independent claim 1 render claims 1-6 allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and whose electronic mail address is [justin.darrow@uspto.gov](mailto:justin.darrow@uspto.gov). The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is 571-273-8300. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers

transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to 571-273-8300 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

August 15, 2005

*Justin Darrow*  
JUSTIN T. DARROW  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100